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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/041,569	01/10/2002	Giuseppe Dal Pra	Q67744	5210

3624            7590            04/17/2003

VOLPE AND KOENIG, P.C.  
UNITED PLAZA, SUITE 1600  
30 SOUTH 17TH STREET  
PHILADELPHIA, PA 19103

EXAMINER
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LUONG, VINH

ART UNIT	PAPER NUMBER
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3682

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DATE MAILED: 04/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. <b>10/041,569</b>	Applicant(s) <b>DAL PRA</b>
	Examiner <b>Luong</b>	Art Unit <b>3682</b>
<i>-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</i>		
<b>Period for Reply</b> A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.		
<ul style="list-style-type: none"> <li>- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.</li> <li>- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.</li> <li>- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.</li> <li>- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).</li> <li>- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).</li> </ul>		
<b>Status</b>		
1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>4/9/03</u>		
2a) <input type="checkbox"/> This action is FINAL.                    2b) <input checked="" type="checkbox"/> This action is non-final.		
3) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11; 453 O.G. 213.		
<b>Disposition of Claims</b>		
4) <input checked="" type="checkbox"/> Claim(s) <u>1-8</u> is/are pending in the application.		
4a) Of the above, claim(s) <u>7 and 8</u> is/are withdrawn from consideration.		
5) <input type="checkbox"/> Claim(s) _____ is/are allowed.		
6) <input checked="" type="checkbox"/> Claim(s) <u>1-6</u> is/are rejected.		
7) <input type="checkbox"/> Claim(s) _____ is/are objected to.		
8) <input type="checkbox"/> Claims _____ are subject to restriction and/or election requirement.		
<b>Application Papers</b>		
9) <input checked="" type="checkbox"/> The specification is objected to by the Examiner.		
10) <input checked="" type="checkbox"/> The drawing(s) filed on <u>1/10/02</u> is/are a) <input type="checkbox"/> accepted or b) <input checked="" type="checkbox"/> objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).		
11) <input type="checkbox"/> The proposed drawing correction filed on _____ is: a) <input type="checkbox"/> approved b) <input type="checkbox"/> disapproved by the Examiner. If approved, corrected drawings are required in reply to this Office action.		
12) <input type="checkbox"/> The oath or declaration is objected to by the Examiner.		
<b>Priority under 35 U.S.C. §§ 119 and 120</b>		
13) <input checked="" type="checkbox"/> Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) <input checked="" type="checkbox"/> All b) <input type="checkbox"/> Some* c) <input type="checkbox"/> None of: 1. <input checked="" type="checkbox"/> Certified copies of the priority documents have been received. 2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____. 3. <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). <i>*See the attached detailed Office action for a list of the certified copies not received.</i>		
14) <input type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e). a) <input type="checkbox"/> The translation of the foreign language provisional application has been received.		
15) <input type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.		
<b>Attachment(s)</b>		
1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)		
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)		
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____		
4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____		
5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)		
6) <input type="checkbox"/> Other: _____		

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1. Applicant's election with traverse of the species of Figs. 1-5 in Paper No. 9 is acknowledged. The traversal is on the ground(s) that no serious burden exists in examining all of the claims in this application. This is not found persuasive because:

(A) the species are patentably distinct. Applicant apparently concedes to this fact since applicant does not submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. The patentably distinct species render undue burden to search all of the species in this application; and

(B) applicant's claims recite mutually exclusive characteristics, e.g., claim 8 recites the limitations "said rocker arm is ring-shaped" which under the disclosure is found in the species of Figs. 6-9, but not in the species of Figs. 1-5. The mutually exclusive characteristics render undue burden to search all of the species in this application.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 7 and 8 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 9.

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said,"

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should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

4. The abstract of the disclosure is objected to because the abstract: (a) exceeds 150 words in length; and (b) uses legal phraseology "said." Correction is required. See MPEP § 608.01(b).

5. The listing of references in the specification (e.g., pages 1 and 2) is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

6. The information disclosure statement filed on January 10, 2002 which is incorporated into the specification (pages 1 and 2) fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

7. The drawings are objected to because each part of the invention, such as, (a) the control cable in line 11 of claim 1 and line 5 on page 3 of the specification; and (b) the release direction of the cable in claim 1 should be designated by a referential numeral or character. A proposed drawing correction

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or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

8. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed features, such as, the end portion of a control cable of a derailleur and the release direction of the cable in claim 1 must be shown or the features canceled from the claims. No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

9. The disclosure is objected to because of the following informalities: each part of the invention, such as, (a) the end portion of the control cable in line 11 of claim 1 and line 5 on page 3 of the specification; and (b) the release direction of the cable in claim 1 should be designated by a referential numeral or character. Appropriate correction is required.

10. Claims 1-6 are objected to because of the following informalities: the claims contain typographical or grammatical error, e.g., "comprising," in line 2 of claim 1 should have been "comprising:". Appropriate correction is required.

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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The term, such as, "*substantially*" in claim 1 is a relative term which renders the claims indefinite. The term "*substantially*" is not defined by the claims, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear, *e.g.*, what range of angles or degrees defined by the first and second axes is required in order to be considered as being "*substantially orthogonal*."

No antecedent basis is seen for the terms, such as, "the handlebar" in lines 3 and 4 of claim 1, and "said rocker arm" in claims 3, 5, and 6.

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claims 1, 2, and 4, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Romano'683 (US Patent No. 5,257,683).

Regarding claim 1, Romano'683 teaches a combined gear change and brake control unit for a bicycle comprising,

a support body 3 which can be fastened to a handlebar 1 of the bicycle,  
a brake control lever 12 pivotally mounted on the support body 3 around a first axis 11 (ibid., line 21 et seq., column 5),  
a gear change control unit carried by the support body 3, comprising a shaft 24 turning around a second axis 23, either orthogonal or substantially orthogonal to said first axis 11, in which

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the shaft 24 carries a pulley 27 on which an end portion 29a of a control cable 29 of a derailleuer is destined to be wound (Fig. 2, id., line 5 et seq., column 6), and in which said shaft 24 is subject to a return torque tending to turn the shaft 24 toward a direction in which the cable 29 is released,

a gear change lever 50 (Fig. 1) arranged behind the brake control lever 12 for controlling the rotation of said shaft 24 in a direction of most winding of the cable 29 and

a button lever 37 (Figs. 2, 3, and 5) arranged on a side of said support body 3 for controlling the rotation of said shaft 24 in the release direction of the cable 29,

wherein the gear change control unit comprises a ratchet mechanism 25, 34-36, etc. controlled by said button lever 37 and subject to assuming a home position and an active position, the ratchet mechanism is arranged so to leave the shaft 24 free to turn by a predetermined amplitude in the release direction of the cable 29, under the action of said return torque following each variation of position of the ratchet mechanism 25, 34-36, etc. between the home position and the active position, and vice versa. Ibid., line 15 et seq., column 6, and claims 1-9.

Regarding claim 2, said ratchet mechanism comprises a gear 25 fastened to the support body 3 with a first and a second meshing unit 26 (Fig. 4) cooperating with said gear 25.

Regarding claim 4, the first and second meshing unit 26 are arranged so to retain the gear 25 in said release direction of the cable 29.

15. Claims 3, 5, and 6 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

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16. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Campagnolo'951 (Fig. 1), Romano'913 (Figs. 8 and 9), Romano'776 (Figs. 3-5), Campagnolo'372 (arm 13b in Fig. 3), Dal Pra'401 (Figs. 1-7), Campagnolo'195 (arm 13b), and Nagano'692 (units 51 and 81).

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Luong whose telephone number is (703) 308-3221. The examiner can normally be reached on Monday-Thursday from 8:30 AM EST to 7:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bucci, can be reached on (703) 308-3668. The fax phone number for this Group is (703) 305-7687. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1113.

Luong

April 15, 2003



Vinh T. Luong  
Primary Examiner